

## REMARKS

### Administrative Overview

Applicants confirm election of Group I, claims 33-34, 38, 42-43, 46, 48-49, 54-56, and 59-70. Applicants cancel without prejudice withdrawn claims 36, 37, 39, and 71, reserving the right to pursue the subject matter of these claims in one or more divisional and/or continuation applications. Applicants also cancel without prejudice claim 38.

Without acquiescing to any rejection, Applicants amend claim 33 and add new (dependent) claims 72-79. No new matter is added thereby.

The amendment of independent claim 33 is supported in the specification as originally filed, for example, in Figure 2 and at page 12, line 4, to page 13, line 15.

New claims 72-79 are supported in the specification as originally filed, for example, as indicated in the table below:

<u>Claim</u>	<u>Example of support in specification</u>
72	Page 60, lines 4-5
73	Page 58, lines 10-12
74	Page 60, lines 4-5
75	Page 58, line 15
76	Page 61, lines 9-10
77	Page 61, lines 1-3
78	Page 61, lines 11-14
79	Page 61, lines 11-14

Following entry of this paper, claims 33, 34, 42, 43, 46, 48, 49, 54-56, 59-70, and 72-79 will be pending. Claim 38 stands as rejected under 35 USC 112, second paragraph. Claims 33, 38, 42-43, 48, 54-56, 60-67, and 70 stand as rejected under 35 U.S.C. 102(a) as allegedly being anticipated by U.S. Patent No. 5,845,639 (**Hochman**). Claims 34, 46, 49, 59, and 68-69 stand as rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over **Hochman** in view of U.S. Patent No. 6,241,662 (**Richards-Kortum**). Applicants traverse these rejections, as discussed below.

### Claim 33 satisfies 35 USC 112, second paragraph

Amended independent claim 33 includes the limitation of dependent claim 38, which Applicants presently cancel. The Office action rejected dependent claim 38 under 35 USC 112, second paragraph, as allegedly being “indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention.” The rejection is reproduced below [emphasis added]:

9. Claim 38 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether applicant refers to a device that obtains spectral data or one that obtains a plurality of sequential images or an additional device.

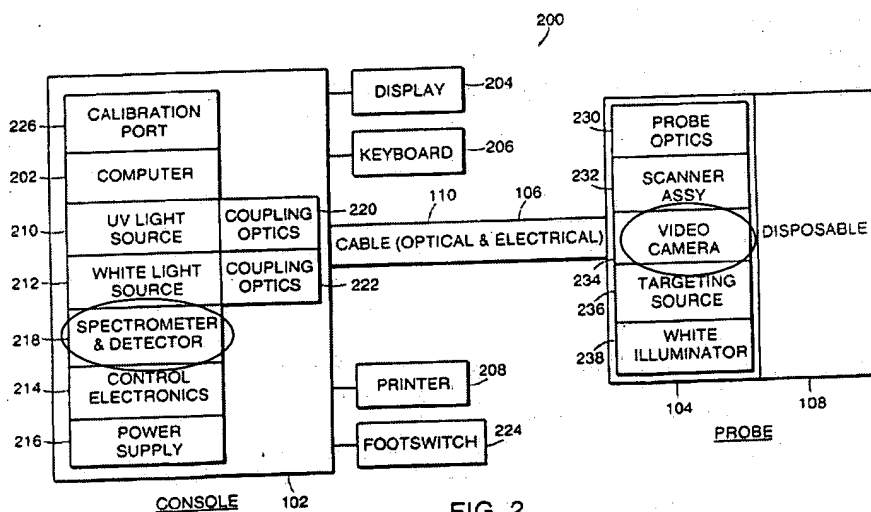
Without acquiescing to any rejection, Applicants amend independent claim 33 to include the limitation of claim 38, but with further clarification. Amended claim 33 recites, “wherein said sample motion is a relative motion between said sample and a detection device *that obtains said plurality of sequential images and said spectral data.*” This amendment is supported in the specification as originally filed, as discussed herein below; no new matter is added.

The amended claim makes clear that the recited “detection device” obtains *both sequential images and spectral data*. Applicants assert that claim 33 satisfies 35 USC 112, second paragraph.

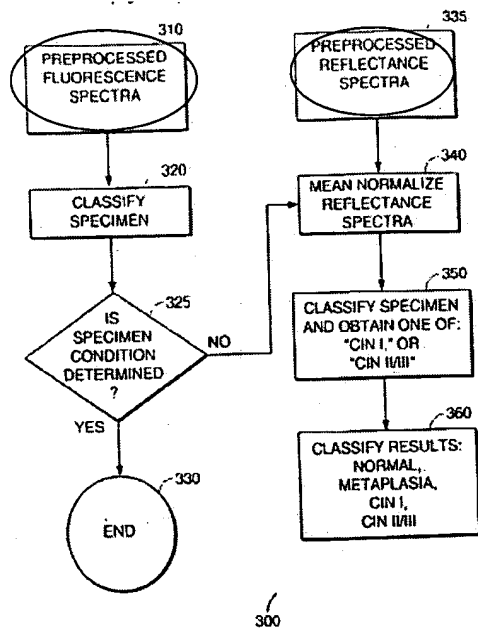
Independent claim 33 is patentably distinguished from Hochman

Without acquiescing to the rejections, Applicants amend claim 33 to recite, “wherein said sample motion is a relative motion between said sample and a detection device that obtains said plurality of sequential images and said spectral data.”

The amendment is supported in Figure 2 and at page 12, line 4, to page 13, line 15. Figure 2 is a block diagram of a spectroscopic system and is reproduced below [emphasis added]:



The “plurality of sequential images” and the “spectral data” recited in claim 33 are separate and distinct from each other. For example, the “video camera” at reference 234 of the device shown in Figure 2 above is for “observing and recording visual images of the specimen under analysis [emphasis added],” (p. 12, lines 18-19), and the “spectrometer & detector” at reference 218 detects spectral data from the tissue sample as a function of location (p. 13, lines 7-15). The spectral data may include, for example, fluorescence and/or reflectance spectra, which may be used to classify a region of tissue, as shown in Figure 3, reproduced below (emphasis added):



Thus, motion-corrected spectral analysis of a tissue sample is made possible by the method of claim 33, which was not heretofore disclosed or suggested.

**Hochman** does not disclose obtaining both spectral data and a sequence of images from a tissue sample. Rather, **Hochman** describes obtaining a video signal of an area of interest over time, and *using the video signal itself* to differentiate tumor tissue from normal tissue by observing the kinetics of dye uptake (see col. 5, lines 15-39).

Thus, **Hochman** fails to teach or suggest all of the limitations of independent claim 33. Applicants respectfully request the reconsideration and withdrawal of the rejection of claim 33 and passage of claim 33 to allowance in due course.

Dependent claims 38, 42-43, 48, 54-56, 60-67, and 70 are patentable in light of **Hochman**

Each of claims 38, 42-43, 48, 54-56, 60-67, and 70 depends directly or indirectly from independent claim 33, and therefore contains all of the limitations of claim 33. Thus, for at least

the reasons discussed above with respect to claim 33, **Hochman** fails to teach or suggest all of the limitations of these dependent claims. Applicants respectfully request the reconsideration and withdrawal of any rejection of any of these dependent claims, at least for this reason.

Dependent claims 34, 46, 49, 59, and 68-69 patentably distinguish from the combination of **Hochman** and **Richards-Kortum**

Claims 34, 46, 49, 59, and 68-69 stand as rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over **Hochman** in view of **Richards-Kortum**. Neither **Hochman** nor **Richards-Kortum** disclose obtaining both spectral data and a sequence of images from a tissue sample, as recited in claim 33, from which these claims depend directly or indirectly. Therefore, Applicants respectfully request the reconsideration and withdrawal of any rejection of any of these dependent claims, at least for this reason.

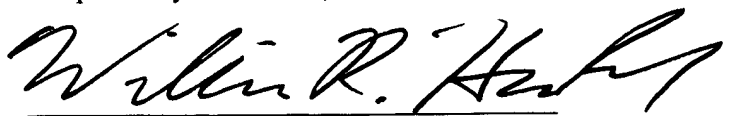
Previous double patenting rejections appear to have been reconsidered and withdrawn

Various claims of the present application were rejected and/or provisionally rejected by the Examiner on the grounds of nonstatutory obviousness-type double patenting. Although not directly addressed in the Office Action, it appears these rejections have been reconsidered and withdrawn. Applicants request clarification. In the event these rejections have not been withdrawn, Applicants request that they be reconsidered and/or held in abeyance until the pending claims are found otherwise patentable in light of the cited art.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request withdrawal of all rejections and objections, and allowance of claims 33, 34, 42, 43, 46, 48, 49, 54-56, 59-70, and 72-79 in due course. The Examiner is hereby cordially invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,



William R. Haulbrook, Ph.D.  
Attorney for Applicants  
Goodwin Procter LLP  
Exchange Place  
Boston, Massachusetts 02109  
Customer No. 051414

Date: October 10, 2006  
Reg. No. 53,002

Tel. No.: (617) 570-1013  
Fax No.: (617) 523-1231

1734888